

REMARKS

Claims 1, 4-15, and 19-36 are presented for the Examiner's review and consideration. In this response, claims 1 and 15 have been amended. Applicant believes the claim amendments and the accompanying remarks herein serve to clarify the present invention and are independent of patentability. No new matter has been added.

35 U.S.C. §112 Rejection

Claims 1 and 4-14 were rejected under 35 U.S.C. §112 second paragraph, for insufficient antecedent basis for the limitation "the skim cut" in claim 1. Accordingly, claim 1 has been amended in response to the rejection to alternatively recite "the cut of the section of bone", which Applicant submits has clear antecedent support.

In light of the foregoing, Applicant requests reconsideration and withdrawal of the section 112 rejection.

35 U.S.C. §103 Rejections

Claims 15, 19 and 21-25 were rejected as being unpatentable under 35 U.S.C. §103(a) over Whiteside (US Pat. 4,474,177) ("Whiteside"), and claim 20 was rejected under 35 U.S.C. §103(a) over Whiteside in view of Sherwin (US Pat. 3,750,652) ("Sherwin").

For reasons set forth below, Applicant respectfully submits that these rejections should be withdrawn.

Whiteside fails, *inter alia*, to disclose affixing first and second portions of a total knee replacement component together after both portions have been positioned against the cut bone *on the same side of the joint*, as is claimed in claim 15. The cited portion of Whiteside, Col. 11, lns. 18-24, describes femoral and tibial portions of an implant, which are necessarily not positioned on the same side of a joint.

Applicant further respectfully suggests that substantially reducing incision size is clearly not a matter of obvious design choice. Incision size directly correlates, at least, to the problems of disfigurement, tissue necrosis, prolonged recovery time, nerve damage, circulation damage, and opportunity for infection. Reducing incision size is therefore always a major motivation for

any surgical procedure, and therefore it can be assumed that a known procedure is already using the shortest possible incision. Accordingly, a reduction in incision size *may be presumed to involve a non-obvious change* in the procedure, otherwise the improvement may be expected to already have been carried out. Accordingly, Applicant respectfully asserts that the cited references do not provide a method which enables a reduced size incision, and particularly an incision of 13 cm or less, as is claimed in claim 15, nor do they suggest or teach same, and therefore do not render the claim obvious. Additionally, while some individual portions of the instrument may appear to be less than 13cm, as cited in the rejection, the assembled tool, shown in Fig. 21, clearly requires a fully exposed joint, as was customary in the prior art.

The rejection further states that, since “cutting is happening within the incision”, the prior art meets the claimed element of “at least a portion of said cut bone being located in the interior of the body with respect to the incision”. Applicant respectfully disagrees. The incision externally exposes an area of the body, and interior portions of the body are those portions not exposed by the incision. However, to advance prosecution, claim 15 has been amended to recite, instead, that a portion of the cut bone is “enclosed by overlying skin and not exposed by the incision”. Support for this amendment may be found, for example, in paragraphs [039]-[050], particularly paragraph [048], and Fig. 9, which shows the extent of the incision, and Fig. 13, which illustrates the path of the cutting tool.

Accordingly, Applicant respectfully submits that claim 15 is patentable over Whiteside, or Whiteside in view of Sherwin. As claims 19 and 20-25 depend from claim 15, these dependent claims necessarily include all the elements of their base claim. Accordingly, Applicant respectfully submits that the dependent claims are allowable over the cited references at least for the same reasons.

In light of the foregoing, Applicant requests reconsideration and withdrawal of the section 103 rejections.

Allowable Subject Matter

Applicant acknowledges with appreciation that claims 26-36 were allowed, and that claims 1 and 4-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. § 112 2nd paragraph.

Applicant respectfully submits that the rejection under section 112 has been addressed, above, and therefore requests allowance of claims 1 and 4-14, as well.

Conclusion

In light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested.

If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee of \$810 is believed to be due for an RCE. However, please charge any required fee (or credit overpayments) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A04-012-1A).

Respectfully submitted,

/ Gary S. Winer /

Gary S. Winer, Reg. #31,806 for
Paul D. Bianco, Reg. # 43,500

Customer Number: 33771
FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO P.L.
21355 East Dixie Highway, Suite 115
Miami, Florida 33180
Tel: 305-830-2600; Fax: 305-830-2605
e-mail: pbianco@focusonip.com